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EXAMINER

GRAHAM, MARK S

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3711

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/764,332
Filing Date: January 23, 2004
Appellant(s): LAFALCE, LAWRENCE P.

**MAILED
FEB 27 2007
GROUP 3700**

Cynthia S. Murphy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/7/06 appealing from the Office action mailed 3/2/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,036,606	Dumas	3-2000
52-20141	Kokai	2-1977

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

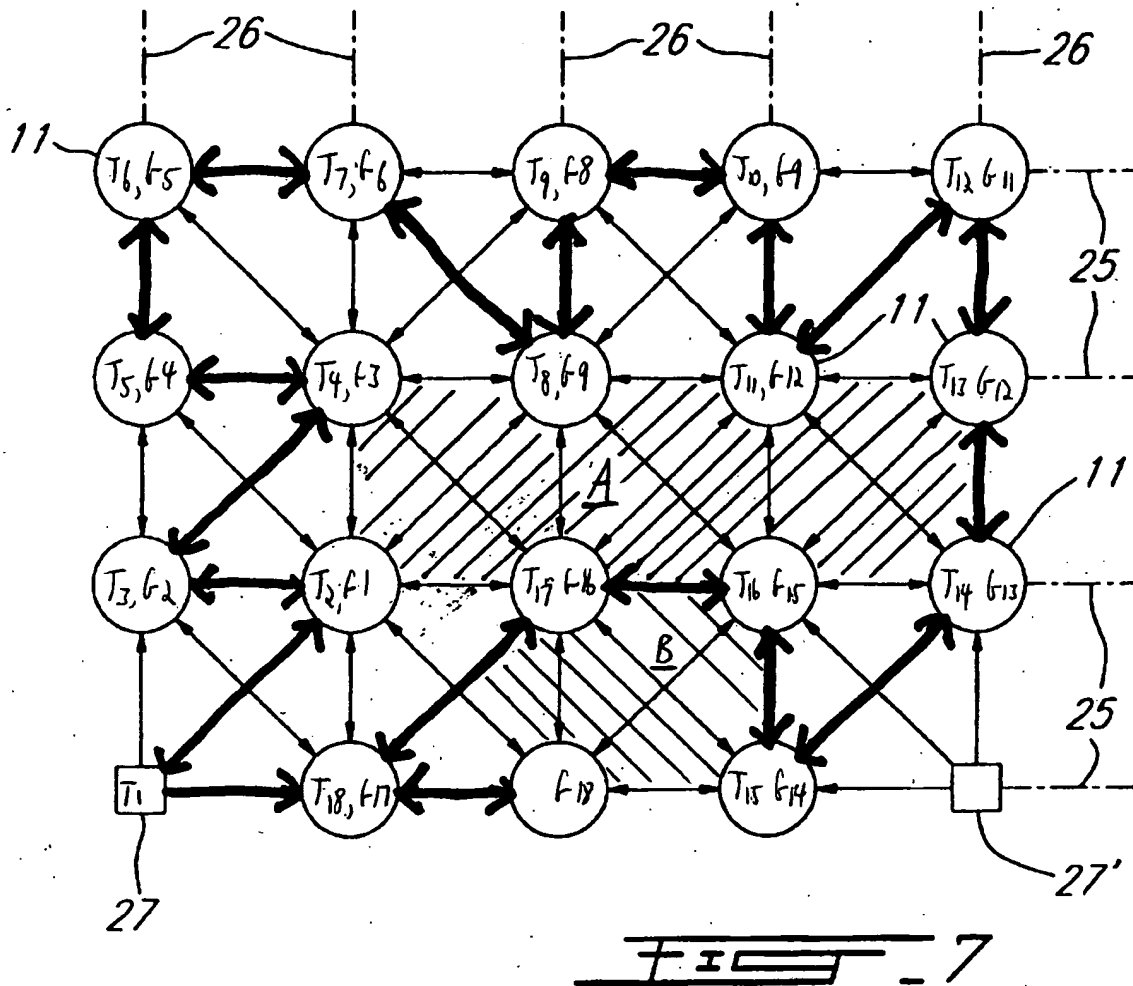
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dumas.

As disclosed by Dumas in Fig. 7 a golf course may be set up in the manner claimed in claims 16-18. A green and a tee or tees are located at each node. The areas of the course not being played or the areas between fairways may be considered the central non-course region. Below, the examiner has shown how a golf course comprising 18 tee areas T1 to T18 and 18 green areas G1 - G18 as claimed may be laid out and played with regard to Dumas's Fig. 7 embodiment with non-course regions such that a doughnut or horseshoe is formed around the non-course region. The area shaded A is considered a non-course region on a doughnut shaped golf course layout, and the area shaded B is considered the non-course region on a horseshoe shaped golf course layout. While not shown below, the arrangement as disclosed by Dumas in Fig. 5 also anticipates claims 16 and 17.



The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumas in view of Kokai.

Dumas locates a clubhouse at an edge of the course. However it is commonly known that such may be centrally located or edge located depending on the geography of the particular terrain where the course is built. Kokai discloses one example of a centrally located clubhouse. It would have been obvious to one of ordinary skill in the art to so locate Dumas' clubhouse if it was desired to provide a more central location on the golf course or to better fit the geography of the particular golf course.

Regarding claim 20, if T1 is located at the T18, G17 node as depicted above rather than point 27, T1 may be the first tee-area and G18 may be the final green-area whether the course is played in the first direction or the second direction as can be clearly seen in the above rendering of Dumas' Fig. 7 golf course.

(10) Response to Argument

Appellant's first argument is that if 18 holes of golf are played on Dumas' arrangement the central area could not be a non-course area. In response, attention is directed to Dumas' Fig. 7 as depicted above, which clearly shows that 18 holes can be played clockwise and counterclockwise as claimed while leaving a non-course area, an area not part of the 18 hole course, at a central location which allows for a doughnut or horseshoe shaped configuration.

Appellant's second argument is that smaller areas between the fairways of different holes may not be considered non-course regions because no visible or

invisible boundaries separate them from the course. It is first noted that the claims do not require any such boundaries. Also, any golf course by definition has out of bounds areas bordering the fairways, and these areas can be seen where clumps of woods appear in Fig. 1 of Dumas. These areas may clearly be considered "non-course regions" as claimed. Appellant's non-course regions contain for example the clubhouse. Dumas' non-course regions in Fig. 1 contain clumps of woods. In both instances these are areas on the golf course which are in actuality non-course regions because no play takes place on them.

Appellant's next argument pertains to claim 19, which requires at a minimum a clubhouse at a central non-course area. The examiner concedes that Dumas does not show this particular feature. However, the concept of centrally locating the clubhouse is clearly not new as depicted for example by Kokai which has been cited solely for what is disclosed in the Abstract and lone figure. Removal of a single fairway path in Dumas to accommodate a club house with the loss of function of that one fairway does not destroy Dumas' concept and course. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Art Unit: 3711

Moreover, the claim only requires that one of the recited elements be centrally located. As can be seen in Fig. 1 of Dumas there is considerable distance between fairways where such an element could have been located if desired.

The final argument advanced by appellant concerns claim 20 and the starting tee position. In response the examiner simply notes that nothing in Dumas requires starting from any particular tee of Dumas. As is commonly known, play may begin at any point on a golf course as for example in a shotgun start. Moreover, the course need only be capable of being laid out as claimed. The method by determining where one starts to play is not at issue in the instant article claims.

For the above reasons, it is believed that the rejections should be sustained.

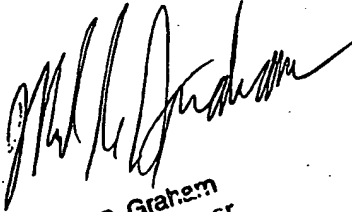
Respectfully submitted,

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